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REMARKS

In the office action mailed June 29, 2006, Examiner rejected claims 1-10 and 12-20 as being unpatentable over Amundson et al in view of Hicks and Dunning.

Examiner notes the following deficiencies in the primary cited reference; namely Amundson:

(1) "Amundson et al., does not disclose the means to releasably mount the shopping list on the first surface of the planar member";

(2) "Amundson et al., does not disclose the means to mount on the second side of the planar member, opposite the first side, to releasably mount the planar member on the flat substrate";

(3) "Amundson et al., does not disclose the means to releasably mount the planar member of the flat substrate"; and,

(4) "Amundson et al., does not disclose the friction member mounted in cooperation with the aperture when the clip is in the open position so as to bear the friction member against and frictionally engage the handle when the handle is releasably mounted in the aperture".

Examiner combines the teaching of Amundson with the teaching of Hicks to cure the first deficiency. Examiner combines the teaching of Amundson with the teaching of Dunning to cure the second and third deficiencies, which applicant takes to refer to the same claim element; namely, the element in claim 1 claiming "means mounted on a second side of said planar member, opposite said first side, for releasably mounting said planar member on a flat substrate," and Examiner combines the teaching of Amundson with the teaching of Hicks to cure the fourth deficiency.

While applicant respectfully submits that the above combinations of the teaching of Amundson with the teaching of Hicks and Dunning to cure all of the deficiencies in the primary cited reference are not proper, applicant proposes to restrict applicant's observations in the comments that follow to only deficiencies 2 and 3.

Amundson teaches a "book-like shopping cart attachment" (Abstract) which "during periods of non-use can be folded like a book and placed in a purse or in an automobile glove compartment" (column 1, lines 26-28), wherein when "the device is removed from the cart and folded for storage, the hooks straddle the folded leaves of the device and tend to hold the leaves in their closed or folded positions for added convenience." (column 1, lines 59-63). The folding of the leaves so as to allow straddling of the hooks, it is respectfully submitted, destroys the utility of the Amundson device for writing on a shopping list when the device is mounted on for example a flat substrate such as a refrigerator door. That is, in the device of Amundson, upon the teaching of Amundson, in order to remove the hooks from extending from the backbone, that is the back of the device, which would be required were the device of Amundson at all adapted for releasably mounting onto a flat substrate, the hooks thereby force close the leaves of the book-like structure rendering it impossible to use the book-like structure to write on the shopping list. Consequently, it cannot have been obvious without the benefit of impermissible hindsight to combine the device of Amundson with that of Dunning (magnets 25) so as to for example adapt the Amundson device for use on a refrigerator door. Simply put, if you somehow mount the back of the Amundson device on a refrigerator door, the hooks will force the leaves closed so that you cannot write on the shopping list.

Examiner is respectfully asked to note that claim 1 has been amended to clarify the patentable distinction of the present invention over the cited art. In particular, claim 1 is amended to clarify that the planar member supports a shopping list so that the shopping list may be written upon by a user. Clearly this is a primary function of the shopping list writing tablet according to the present invention. Further, claim 1 is amended to clarify that the means for releasably mounting the planar member on the flat substrate mounts the planar member on the flat substrate in an un-deformed planar state, that is, in a planar state so that it may be used for writing on the shopping list and not folded up like a book, so that the shopping list may be written upon by a user. Further still, claim 1 is amended to clarify that the means for releasably mounting the planar member on a flat substrate is itself substantially planar and has an exterior surface, opposite to the second side of the planar member, so that, in the closed position, the clip is retracted adjacent the second side of the planar member when it is in its un-deformed planar state, and the clip is recessed behind the exterior surface as previously defined. No new subject

matter has been added that is not either expressly taught or clearly inferred from the disclosure as filed.

Although unnecessary, Examiner is respectfully asked to note the following two clear propositions of law: firstly, that absent some teaching or suggestion supporting the combination of the claimed elements, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention (In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (Fed. Cir. 1988)); and, secondly, that the teaching or suggestion to make the claimed combination of elements of the invention and the reasonable expectation of success of such combination must both be found in the prior art (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Nowhere in the teaching of Amundson does it state or suggest that the book-like structure be somehow held open and the hooks somehow kept from interfering so that the book-like structure could be mounted in its open position onto for example a fridge door by the use of magnets on the back of the backbone member and leaves. The clear conclusion from the teaching in Amundson is, rather, to teach away from the use of the book-like device for mounting onto a refrigerator door in its open position by the mere fact that, on the clear teaching of Amundson, it is not possible to do so with the structure given.

Referring now to the Dunning cited reference, Dunning neither teaches nor suggests the use of clips which fold out for use, and which fold away into a recessed position so that the note pad may be mounted to for example a refrigerator door using the magnets 25. Rather, Dunning discloses straps which are attached to the left and right supports for removably attaching the shopping organizer of Dunning to a shopping cart handle (column 3, lines 20-22). It is taught that the note pad is mounted to a cart handle by straps such as leather belt-like straps, ribbons, strings, or preferably hook-and-loop material, or elastic-type material such as rubber, and that the straps in their stored position are wrapped around their corresponding supports and pegs (column 5, lines 23-33). The supports and pegs around which the straps are wrapped for storage are taught to extend laterally outwardly from the sides of the note pad. There is no teaching or suggestion to somehow recess the straps on the side of the note pad on which the magnets are mounted so as to conveniently store the straps out of the way while still allowing the

note pad to be mounted to a refrigerator door by the use of the magnets. Consequently, again, it can only be with the benefit of hindsight that Examiner finds it obvious to combine Amundson and Dunning in that Dunning neither teaches nor suggests the advantage to be gained by recessing the straps into the second side of the note pad.


With respect to the cited Hicks reference, like the teaching of Amundson, Hicks discloses a structure wherein it is not possible without dismantling the Hicks device, to use it in conjunction with magnets for example to mount to a refrigerator door. In particular, Hicks teaches that brackets 12 including one having end 67 is secured to plate member 21 by rivets 68 or the like. Thus in order that plate 21 may be mounted flush against a refrigerator door, it would be necessary to destroy the rivets so as to remove brackets 12 to thereby remove the obstruction from the back of the shopping cart list holder to allow it to be mounted to a flat substrate. Further, rather than teaching that brackets 12 may be folded into a recessed position on the back of plate 21 to thereby provide for the mounting of the plate onto for example a refrigerator door, Hicks instead teaches that the brackets are riveted into place on the back of the plate member 21 thereby teaching away from the solution according to the present invention which provides for both convenient mounting of a shopping list holder onto a shopping cart handle, and for mounting of the shopping list holder onto for example the door of a refrigerator.

With respect to the dependent claims which all depend directly or indirectly from claim 1, it is respectfully submitted that they are patentable for at least the reason that they depend from claim 1 which itself patentably distinguishes over the prior art.

Examiner is respectfully requested to now pass this application to allowance.

Respectfully submitted,
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